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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,540	08/18/2000	Dr. Santosh Misra	2847-54358	6802

7590

12/12/2001

Klarquist Sparkman Campbell Leigh & Whinston LLP  
One World Trade Center  
121 S W Salmon Street  
Suite 1600  
Portland, OR 97204-2988

EXAMINER

STRZELECKA, TERESA E

ART UNIT

PAPER NUMBER

1656

5

DATE MAILED: 12/12/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/641,540

Applicant(s)

MISRA, DR. SANTOSH

Examin r

Teresa E Strzelecka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: .

## DETAILED ACTION

### *Election/Restrictions*

1. Prior to setting forth the Restriction Requirement, it is pointed out that applicants have presented claims 1, 7-16, 19-21 in improper format. The claims are improperly joined as the various groups indicated below appear to encompass distinct inventions (polynucleotides encoding sequences with different SEQ ID NOs) to such an extent that they are considered separately patentable. Therefore, the restriction will be set forth for each of the various groups, irrespective of the improper format of the claims, because these are not proper species.

In addition, Groups detailed below reads on patentably distinct Groups drawn to multiple SEQ ID Numbers. The sequences are patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group drawn to amino acid or nucleic acid sequences, the Applicants must further elect a single amino acid or a single nucleic acid sequence (See MPEP 803.04).

2. In addition, it is noted that claims 10-14, drawn to a transgene comprising at least one ORF operably linked to the promoter of claim 1 would be subject to further restriction, as each protein comprising more than one polypeptide would differ in structure and modes of action to such extent as to be considered patentably distinct.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 (in part), 2, 7-16, 19-21 (all in part), drawn to a recombinant promoter comprising nucleic acid sequence of SEQ ID NO: 17, a vector, a host cell, a transgene, a plant cell and a method of expressing a protein, classified in class 536, subclass 24.1.

If Group I is elected, it will be examined to the extent that it reads on SEQ ID NO: 17.

- II. Claims 1 (in part), 3, 7-16, 19-21 (all in part), drawn to a recombinant promoter comprising nucleic acid sequence of SEQ ID NO: 22, a vector, a host cell, a transgene, a plant cell and a method of expressing a protein, classified in class 536, subclass 24.1.

If Group II is elected, it will be examined to the extent that it reads on SEQ ID NO: 22.

- III. Claims 1 (in part), 4, 7-16, 19-21 (all in part), drawn to a recombinant promoter comprising nucleic acid sequence of SEQ ID NO: 23, a vector, a host cell, a transgene, a plant cell and a method of expressing a protein, classified in class 536, subclass 24.1.

If Group III is elected, it will be examined to the extent that it reads on SEQ ID NO: 23.

- IV. Claims 1 (in part), 5, 7-16, 19-21 (all in part), drawn to a recombinant promoter comprising nucleic acid sequence of SEQ ID NO: 24, a vector, a host cell, a transgene, a plant cell and a method of expressing a protein, classified in class 536, subclass 24.1.

If Group IV is elected, it will be examined to the extent that it reads on SEQ ID NO: 24.

- V. Claims 1 (in part), 6, 7-16, 19-21 (all in part), drawn to a recombinant promoter comprising nucleic acid sequence of SEQ ID NO: 25, a vector, a host cell, a transgene, a plant cell and a method of expressing a protein, classified in class 536, subclass 24.1.

If Group V is elected, it will be examined to the extent that it reads on SEQ ID NO: 25.

- VI. Claims 17, 18, drawn to a protein, classified in class 530, subclass 300.

- VII. Claims 22-29, drawn to a recombinant promoter comprising different promoter elements, a vector, a host cell, a transgene, a plant cell and a method of expressing a protein, classified in class 536, subclass 24.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-V and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are promoters with different sequences resulting in a different modes and effects of promoter function.
3. Inventions VI and (I-V, VII) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the protein of Group VI and promoters of Groups I-V and VII are differing biochemical entities having differing biochemical properties, structures and effects.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa E Strzelecka whose telephone number is (703) 306-5877. The examiner can normally be reached on M-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached at (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

TS  
December 10, 2001

TS

*Kenneth R. Horlick, Ph.D.*  
KENNETH R. HORLICK  
PRIMARY EXAMINER  
GROUP 1600 12/11/01